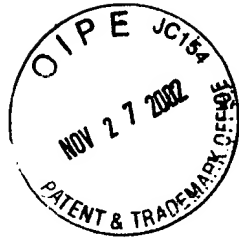


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S&H Form: (40/01)

REPLY/AMENDMENT FEE TRANSMITTAL		Attorney Docket No.	1317.1031D		
		Application Number	09/556,978		
		Filing Date	April 24, 2000		
		First Named Inventor	Young-Nam OH		
		Group Art Unit	2153		
AMOUNT ENCLOSED		\$320.00	Examiner Name	T. Kupstas	DEC 02 2002
FEE CALCULATION (fees effective 10/01/01)					
CLAIMS AS AMENDED	Claims Remaining After Amendment	Highest Number Previously Paid For	Number Extra	Rate	Calculations
TOTAL CLAIMS	6	- 20 =	0	X \$ 18.00 =	\$ 0.00
INDEPENDENT CLAIMS	2	- 3 =	0	X \$ 84.00 =	0.00
Since an Official Action set an <u>original</u> due date of , petition is hereby made for an extension to cover the date this reply is filed for which the requisite fee is enclosed (1 month (\$110); 2 months (\$400); 3 months (\$920); 4 months (\$1,440); 5 months (\$1,960)):					
If Appeal Brief is enclosed, add (\$320)					320.00
If Statutory Disclaimer under Rule 20(d) is enclosed, add fee (\$110)					
Total of above Calculations =					\$ 320.00
Reduction by 50% for filing by small entity (37 CFR 1.9, 1.27 & 1.28)					
TOTAL FEES DUE =					\$ 320.00
(1) If entry (1) is less than entry (2), entry (3) is "0". (2) If entry (2) is less than 20, change entry (2) to "20". (4) If entry (4) is less than entry (5), entry (6) is "0". (5) If entry (5) is less than 3, change entry (5) to "3".					
METHOD OF PAYMENT					
<input checked="" type="checkbox"/> Check enclosed as payment.					
<input type="checkbox"/> Charge "TOTAL FEES DUE" to the Deposit Account No. below.					
<input type="checkbox"/> No payment is enclosed and no charges to the Deposit Account are authorized at this time (unless specifically required to obtain a filing date).					
GENERAL AUTHORIZATION					
<input checked="" type="checkbox"/> If the above-noted "AMOUNT ENCLOSED" is not correct, the Commissioner is hereby authorized to credit any overpayment or charge any additional fees necessary to: Deposit Account No. 19-3935 Deposit Account Name STAAS & HALSEY LLP					
<input checked="" type="checkbox"/> The Commissioner is also authorized to credit any overpayments or charge any additional fees required under 37 CFR 1.16 (filing fees) or 37 CFR 1.17 (processing fees) during the prosecution of this application, including any related application(s) claiming benefit hereof pursuant to 35 USC § 120 (e.g., continuations/divisionals/CIPs under 37 CFR 1.53(b) and/or continuations/divisionals/CPAs under 37 CFR 1.53(d)) to maintain pendency hereof or of any such related application.					
SUBMITTED BY: STAAS & HALSEY LLP					
Typed Name	John H. Stowe			Reg. No.	32,863
Signature				Date	11/27/02

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#10

Docket No.: 1317.1031D

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of:

Young-Nam OH et al.

Serial No. 09/556,978

Group Art Unit: 2153

Confirmation No.

Filed: April 24, 2000

Examiner: T. Kupstas

RECEIVED

DEC 02 2002

Technology Center 2100

For: HYBRID DISC AND METHOD AND APPARATUS FOR DISCRIMINATING SAME

APPELLANT'S BRIEF UNDER 37 C.F.R. §§ 1.191 AND 1.192

Assistant Commissioner
for Patents
Washington, D.C. 20231

Pursuant to the Appellants' earlier filed Notice of Appeal on October 1, 2002, Appellants hereby appeal to the Board of Patent Appeals and Interferences from the final rejection mailed April 8, 2002.

Appellants submit this Appeal Brief in triplicate as required by 37 C.F.R. §1.192(a) along with the filing fee of \$320.00 set forth in 37 C.F.R. §1.117(c).

I. Real Party in Interest

The inventors, Young-Nam Oh and Jae-Hoon Heo assigned all rights in the subject application to Samsung Electronics Co. Ltd., on March 30, 1998, according to the Assignment recorded at Reel 9099, Frame 0158, on April 7, 1998, thus the real party in interest is:

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320.00 OP

Samsung Electronics Co., Ltd.
416, Maetan-dong, Paldal-gu,
Suwon-city, Kyungki-do
Republic of Korea

II. Related Appeals and Interferences

Pursuant to 37 C.F.R. §1.192(c)(2), although the real party in interest has other appeals and interferences, none of the other pending appeals and interferences is believed to directly affect or be directly affected by, or have any bearing upon the decision of the Board of Patent

Appeals and Interferences in this appeal.

III. Status of Claims

Claims 1-3, 19, 23 and 24 are pending in the application. All of claims 1-3, 19, 23 and 24 stand rejected under 35 U.S.C. 103(a).

IV. Status of Amendments

According to the Office Action mailed April 8, 2002, the Amendment filed on January 22, 2002 was apparently entered. A Response Under 37 C.F.R. §1.116 was filed on July 1, 2002, however such response included no claim amendments.

V. Summary of the Invention

The present invention is a hybrid disc for recording information in a plurality of formats, such as for example, a compact disc (CD) format and a digital versatile disc (DVD) format. The hybrid disc of the present invention comprises a substrate, a label printed surface formed on the substrate, a first recording surface having identification information expressing a disc type recorded in a predetermined recording area, and a second recording surface formed below the label printed surface and below the first recording surface. Where the hybrid disc comprises the CD and DVD formats, the DVD recording surface is formed below the CD recording surface. The predetermined recording area where the information expressing a disc type is recorded may be a file which is generally not used, a sector which is predetermined, or a TOC (table of contents).

The invention is especially useable with discs which may be used in a recording and/or reproduction device adapted to record/reproduce data in more than one format, wherein information recorded in one format may be damaged if the recording/reproduction device is set to record/reproduce information in another format.

VI. Concise Statement of Issues Presented for Review

At page 2 of the Office Action of April 8, 2002, claims 1-3, 19, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Admitted Prior Art of Appellants' specification in View of U.S. Patent 5,959,946 to Tognazzini.

At main issue in the present application is whether the Examiner has demonstrated that the invention as claimed would have been obvious to a person of ordinary skill in the art at the

time the invention was made. Another issue is whether the features of the prior art which the Examiner has applied to the claims are fairly taught by the prior art.

VII. Grouping of Claims

The following claims stand or fall together:

- (A) claims 1-3; and
- (B) claims 19, 23 and 24.

VIII. Argument

Group (A)

The present invention was made to solve a problem of damaging discs having a hybrid format where the disc is used in an apparatus adapted to record/reproduce information from discs having one of a plurality of formats. For example, where the recording/reproducing apparatus is adapted to record/reproduce information in a CD format and to reproduce information in a DVD format, a conventional apparatus determines whether the disc is a DVD or a CD format type by attempting to read information recorded on the disc using laser beams associated with the format type. However, if the apparatus should irradiate a recordable CD layer of the hybrid disc with a laser beam suitable for a DVD layer, recorded CD information may be damaged.

Appellants' solution to this problem is to include information in a predetermined recording area of the disc which expresses a disc type, that is, identifies the disc as a hybrid disc. The information expressing a disc type is recorded in the first recording surface.

The Examiner admits that the Admitted Prior Art does not disclose [a disc] having [an] ID information in a predetermined area indicating the type of disc.

The Examiner asserts that Tognazzini discloses a type of hybrid disc wherein there is an area where information indicating the type of disc to be played is contained in a special area. The portion cited by the Examiner, col. 6, lines 33-38, reads as follows:

"For example, the control information can indicate that the disk is a CD and the inputs stored in the read/write portion thereof indicate a playback program or that the disk is a CD-ROM game and the information stored in the read/write part thereof is indicative of the ending game position."

The term *control information* as used at col. 6, line 34, and as used in the previous

sentence at col. 6, line 31, does not refer to information included on the disk as asserted by the Examiner, but as disclosed at col. 6, lines 21-22, refers to information to be kept on RAM 410B of an apparatus shown in FIG. 4.

Although Tognazzini discloses at col. 5, line 60-62, that the apparatus of FIG. 4 reads the disk to determine if the disk is a hybrid disk, there is no indication that the disk comprises "a first recording surface having identification information expressing a disc type, recorded in a predetermined recording area, said first recording surface being formed at a first interval below said label printed surface," as claimed in claim 1, that the disc is a hybrid disc" wherein said predetermined recording area is a file which is generally not used, or a sector which is predetermined, or a TOC (table of contents)" as claimed in claim 3. Further, the disclosure of Tognazzini teaches away from having a disc type expressed on the disc. If Tognazzini contemplated that the disc type was recorded on the disc, there would be no reason to record the serial number of the disc and the corresponding control information on the RAM 410B of the apparatus so that:

"The control information is used as an index to identify the category of the disk and the format of the inputs or information stored on the read/write parts thereof." See col. 6, lines 31-33.

If the disk 100 of Tognazzini included "a first recording surface having identification information expressing a disc type," it would not be necessary to store such information on the RAM 410B in association with the disk serial number for later use.

The Examiner appears to be reading Tognazzini in the light of the disclosure of the present application and concluding that since the apparatus in Tognazzini reads the disk to determine if the disk is a hybrid disk, that Tognazzini must be obtaining such information from "a first recording surface having identification information expressing a disc type" as claimed 1 or from "a predetermined recording area having identification information indicating that the hybrid disc is a hybrid disc type" as claimed in claim 19.

Appellants submit that such a reading of Tognazzini is erroneous and constitutes hindsight analysis which is not permissible.

The present invention must be viewed in light of the problems with which the inventor was solving at the time the invention was made, namely, irradiating a recordable CD surface of a hybrid disk with a laser emitting a frequency intended for irradiating a

DVD surface can result in damage to the CD surface. Appellant's improved hybrid disk, as claimed in claims 1-3, 19, 23 and 24 provide a simple but reliable solution to this problem.

The Examiner has the burden under 35 U.S.C. §103 to establish a prima facie case of obviousness. See *In re Piasecki*, 223 USPQ 785, 787-87 (Fed. Cir. 1984). This burden can only be satisfied by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Fine*, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988).

A necessary part of the Examiner's burden is to correctly interpret the reference. A reference must be evaluated by ascertaining the facts fairly disclosed therein as a whole. *In re Meng and Driessen*, 181 USPQ 94, 97 (CCPA 1974). If the Examiner is permitted to apply a reference in direct contradiction with what the reference fairly discloses, then the patent examining process will be reduced to a speculative endeavor where the claims at issue are judged against the views of the Examiner and not against the prior art. Appellants submit that when taken as a whole, Tognazzini does not include recorded information in predetermined recording area of the disc expressing a disc type.

Judging the Appellants' invention in view of the Appellants' disclosure and then concluding that the Appellants' invention is taught in the prior art is impermissible hindsight. Hindsight cannot be used in determining the issue of obviousness and the reviewer must view the prior art without reading into that art the teachings of the application. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983).

The prior art must suggest the desirability of the modifications in the manner proposed by the Examiner as well as the results to be achieved. *Ex parte Costa*, 211 USPQ 636 (P.O.Bd.App.1978), *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed.Cir.1984), *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed.Cir.1984), *Lear Siegler v. Aeroquip Corp.*, 733 F.2d 881, 221 USPQ 1025 (Fed.Cir.1984) and *Diversitech v. Century Steps*, 850 F.2d 675, 7 USPQ2d 1315 (Fed.Cir.1988).

It is respectfully submitted that the Examiner has not met his burden of demonstrating obviousness within the meaning of 35 U.S.C. §103(a).

Claim 2 is deemed to be patentable at least for similar reasons set forth above regarding claim 1.

Group (B)

Regarding claim 19, Appellants' arguments set forth above regarding the Examiner's erroneous reading of Tognazzini, i.e., concluding that the "control information" mentioned in Tognazzini was information recorded on the disc expressing a disc type, are equally applicable to the rejection of claim 19. Finally, a combination of the Admitted Prior Art and Tognazzini does not disclose a hybrid disc comprising "a first recording surface formed at a first level in said substrate, said first recording surface including a first format type of reproduction data and a predetermined recording area having identification information indicating that the hybrid disc is a hybrid disc type" as claimed in claim 19.

Claims 23 and 24 are deemed to be patentable at least for similar reasons set forth regarding claim 19.

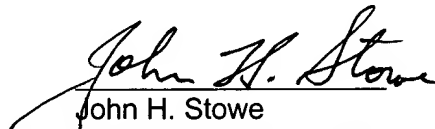
IX Summary

For the forgoing reasons, Appellant submits that the Examiner's rejection of claims 1-3, 19, 23 and 24 is erroneous, and reversal of his decision is respectfully requested.

The required fee of \$320.00 is attached. If any further fees are required, please charge same to deposit account no. 19-3935.

Respectfully submitted,

STAAS & HALSEY


John H. Stowe
Registration No. 32,863

Dated: 11/27/02
700 Eleventh Street, N.W.
Suite 500
Washington, D.C. 20001
(202) 434-1500

X. Appealed Claims

1. A hybrid disc comprising:
a substrate;
a label printed surface formed on said substrate;
a first recording surface having identification information expressing a disc type, recorded in a predetermined recording area, said first recording surface being formed at a first interval below said label printed surface; and
a second recording surface formed at a second interval below said label printed surface;
wherein said second interval is longer than said first interval.
2. A hybrid disc according to claim 1, wherein said first recording surface is a CD (compact disc) recording surface on which CD data is recorded, and said second recording surface is a DVD (digital versatile disc) recording surface on which DVD data is recorded.
3. A hybrid disc according to claim 2, wherein said predetermined recording area is a file which is generally not used, a sector which is predetermined, or a TOC (table of contents).
19. A hybrid disc comprising:
a substrate;
a first recording surface formed at a first level in said substrate, said first recording surface including a first format type of reproduction data and a predetermined recording area having identification information indicating that the hybrid disc is a hybrid disc type; and
a second recording surface formed at a second level in said substrate, said second recording surface including a second format type of reproduction data different from said first type of reproduction data.
23. The disc as claimed in claim 19, wherein one of said first and second recording surfaces is a CD (compact disc) recording surface.
24. (ONCE AMENDED) The disc as claimed in claim 19, wherein one of said first and second recording surfaces is a DVD (digital versatile disc) recording surface.